REMARKS

Reconsideration of the present application is respectfully requested.

I.   Status of the Claims

Claim 47 was previously canceled.

Claims 1-3, 6-10, 12-15, 20, 21, 23, 24, 29, 30, 32, 33-37, 43, 44, and 46 have been amended and no new matter has been added by way of this amendment.

Claims 1-46 are pending.

II.   Status of the Specification

The specification has been amended to correct a typographical error. No new matter has been added.

III.   Acknowledgment of Allowable Subject Matter

Applicants thank the Examiner for the acknowledgment of allowable subject matter in claims 14, 15, 22, 35, 36, 41, and 42. The claims are objected to but would be allowed if amended into independent form.

IV.   Rejections under 35 U.S.C. § 102

Claims 1-12, 17, 21, 24-32, 34, 38-40, and 44-46 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,017,354 to Culp et al. ("Culp"). The Examiner contends that Culp discloses every element of the claims. Applicants respectfully traverse the rejection.

Regarding the rejection of claims 1, 3 and 44, the Examiner contends that "Culp discloses a memory disposed in the sheath (50) of the end-effector." However, Culp's "sheath" is the "motor housing 50 ... [and the t]wo memory units 72 and 74 are fitted in the motor housing 50 of handpiece 32." Culp, column 6, lines 26-52 and *see*, Figures 2 and 3. This is in contrast to the claimed "memory disposed in the sheath of the end-effector."

The sheath of the end-effector, as claimed, is separate from the hand piece containing the electrical components (e.g. transducer and piezoelectric stacks). This separation confers a specific advantage over Culp's design. The Specification states that the:

> memory 400 is advantageously provided in the sheath of the end-effector for reducing unneeded complexity in electrical isolation configurations which contribute to increases in costs, complications in cross-talk noise issues, and adversely affects the ergonomic performance of the hand piece 30. By placing the memory 400 in the sheath of the end-effector, adequate electrical isolation of the circuitry in the memory 400 from the hand piece 30, the human operator thereof, and the patient is readily achieved.

Specification, page 20, lines 11-17. Thus, Culp's memory units are not housed in a sheath, as defined in the Specification and claims, because his memory is not isolated from the electrical components, in particular the motor. The placement of Culp's memory units will cause all of the problems described above and which are solved by the present invention. Further, Culp does not teach or suggest an alternate placement of his memory units. Culp describes the placement of the

memory units in detail and a configuration to ensure accurate readings of his memory units. *See*, Culp, column 6, line 51 to column 8, line 23.

Regarding claims 9, 10 and 12, they also state that the "memory [is] disposed within the end-effector." This has the same benefit as disposing the memory in the sheath and is not taught by Culp. Culp, as submitted above, places his memory units in the same section of housing that houses his motor and they are not "disposed within the end effector."

Claims 5, 7, 8, 21, 24-31, 45, and 46 depend from claims 1, 3 and 44, and claims 11 and 17 depend from claims 9, 10 and 12 and distinguish over the prior art based on their dependence from the independent claims.

Regarding claim 2, the claim has been amended to recite that the "memory periodically adjusting operation of the generator console during the operation of the end-effector to set a cutting rate and degree of tissue hemostasis with the end-effector." Further, claim 32 has been amended to recite "periodically querying the memory during the ultrasonic movement of the end-effector." The memory is

> periodically queried independent of handpiece activation ... [This] allows generally immediate detection of blade change and generally immediate detection of blade type attached. Such information can contribute to diagnostic functionalities that monitor handpiece temperature, temperature rate of change, and other parameters to adjust triggers and thresholds and allow the display of blade type and related parameters in the generator console in advance of the next activation.

Specification, page 21, lines 12-18. The memory is queried to help diagnose the handpiece and provide information to the user during initialization and throughout the use of the handpiece.

In contrast, Culp only queries his memory units once, during initialization. Culp states that:

> When the system 30 determines that a handpiece 32 or 33 has been plugged into the system, control console 36 reads data stored in memory units internal to the handpiece. Based on the retrieved data, the control console 36 configures itself so

that it can supply the appropriately energization signals to handpiece 32 or 33. As part of the initialization process, the control console presents a set of instructions on the display 37 that direct the medical personnel to provide information about any accessories that may be used in conjunction with the handpieces 32 and 33. **Once the requisite instructions are received, the control console then regulates the operation of the handpieces 32 and 33 based on the state of the hand switch 39, the pedals 44 and commands entered through the display 37.**

Culp, column 6, lines 10-23 (emphasis added). Culp does not periodically adjust the operation of

the generator console based on the memory in the handpiece and also does not periodically query

the memory during handpiece use. Culp only reads his memory units when the handpiece is

initially plugged into the system and does not use the memory to diagnose his handpiece during use.

Once the handpiece is in use, Culp controls the handpiece by the switch, pedals, and/or display, the

memory is not read again.

Claims 4 and 6 depend from claim 2 and claims 34 and 38-40 depend from claim 32 and are

allowable based on their dependence from the independent claims and their own recital.

Applicants respectfully submit that Culp does not anticipate all of the elements of the claims

and request that the present rejection be withdrawn.

V.   Rejections under 35 U.S.C. § 103

Claims 18, 19, and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over

Culp in view of U.S. Patent No. 5,400,267 to Denen et al. Claims 20, 24, 37, and 43 stand rejected

under 35 U.S.C. 103(a) as being unpatentable over Culp in view of U.S. Patent No. 6,331,181 to

Tierney et al. Claims 20 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over

Culp in view of U.S. Patent No. 6,298,255 to Cordero et al. Lastly, claims 13 and 16 stand rejected

under 35 U.S.C. 103(a) as being unpatentable over Culp in view of U.S. Patent No. 6,434,507 to Clayton et al. These several rejections are respectfully traversed.

Claims 13, 16, 18-20, 23, and 24 depend from claims 1, 3 and 44, and claims 33, 37, and 43 depend from claim 32. Applicants respectfully submit that Culp does not teach or suggest all the elements of the independent claims. Further, Culp teaches away from any configuration other than his disclosed teaching. Additionally, Denen et al., Tierney et al., Cordero et al., and Clayton et al. do not teach or disclose the elements missing from Culp. Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Based on the foregoing amendments and remarks, this application should be in condition for allowance. Early passage of this case to issue is respectfully requested. However, if there are any questions regarding this amendment, or the application in general, a telephone call to the undersigned would be appreciated since this would expedite the prosecution of the application for all concerned.

Dated: October 4, 2004   Respectfully submitted,

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